

Remarks

For the Specification:

Applicant amends the specification to indicate a current status of a related invention. No new matter is being added.

For the Claims:

Applicants submitted claims 1-19. This Office Action rejects claims 1-19. This Amendment cancels claims 4, 11, and 13, amends claims 1 and 12, and retains claims 2-3, 5-10, and 14-19 as originally submitted. Applicants respectfully request reconsideration in view of the following remarks.

This Office Action objected to claims 1, 11, and 12 due to an informality. In particular, the Office Action objects to the phrase "In a vibration damper, a clamp" included in the preamble of the claims. This Amendment amends claims 1 and 12 per the Examiner's suggestion to recite "A clamp in a vibration damper." In addition, this Amendment cancels claim 11. Accordingly, the objection to claim 11 is now irrelevant.

This Office Action rejects claims 1-3, 5-7, 10, 12, 14-16, and 19 under 35 U.S.C. 102(b) as being anticipated by Hawkins et al., U.S. Patent No. 4,554,402 (hereinafter Hawkins). In addition, this Office Action rejects claims 4 and 13 under 35 U.S.C. 103(a) as being unpatentable over Hawkins.

Independent claim 1 is being amended to include the limitations of dependent claim 4. As such, claim 4 is being canceled. Similarly, independent claim 12 is being amended to

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include the limitations of dependent claim 13. Consequently, claim 13 is being canceled. Due to the modifications of each of independent claims 1 and 12, the rejection of claims 1 and 12 under 35 U.S.C. 102(b) as being anticipated by Hawkins is overcome. Claims 2-3, 5-7, and 10 depend directly or indirectly from amended independent claim 1. Likewise, claims 14-16 and 19 depend directly or indirectly from amended independent claim 12. Consequently, Applicants believe the rejection of claims 2-3, 5-7, 10, 14-16, and 19 under 35 U.S.C. 102(b) is overcome.

The Office Action alleges that Hawkins substantially discloses a clamp as set forth in claim 1. With regard the claimed extension section recited in claim 1, the Office Action apparently equates the Hawkins shield structure 22 with Applicants' claimed extension section originally recited in claim 1. For reasons set forth below, Applicants respectfully disagree that the Hawkins shield structure 22 is a disclosure of the claimed extension section.

Nevertheless, Applicants are amending claim 1 to include the limitations of claim 4 to more clearly recite that which Applicants believe to be the invention. Likewise, Applicants are amending claim 12 to include the limitations of claim 13 to more clearly recite that which Applicants believe to be the invention. Claim 1 was modified to include the claim 4 limitation of "an extension section projecting in a direction transverse to a longitudinal axis of said passageway." Similarly, claim 12 was modified to include the claim 13 limitation of "said first and second extension sections projecting in a direction transverse to a longitudinal axis of said passageway."

The Office Action acknowledges that Hawkins does not explicitly disclose the extension section projecting in a direction transverse to a longitudinal axis of the passageway.

However, the Office Action concludes that it would have been obvious to have the extension section project in a direction transverse to a longitudinal axis of the passageway, since it has been held that rearranging parts of an invention involves routine skill in the art.

At issue here is when given a fair reading, does the prior art teach or suggest all of Applicants' limitations of amended independent claim 1. At further issue is whether modification of Hawkins to something more closely resembling Applicants' invention involves merely rearranging parts of an invention. In this case, Applicants contend that Hawkins fails to teach or suggest the structural limitations recited in amended independent claim 1, i.e., an extension section projecting in a direction transverse to a longitudinal axis of the passageway. Applicants further contend that one would not be motivated to modify the Hawkins device to more closely resemble Applicants' structure without the benefit of hindsight.

Hawkins discloses a vibration damper (10) that includes a clamping member (14) mounted on a conductor. The clamping member (14) includes an integral clamp extension arm (16) extending downwardly from the clamping member (14). Weight structures (23) are located on opposing sides (18) of the clamping arm (16), and elastomer structures (each structure including a pair of spherical damping elements 32 joined together by an integral ring or rib 33, best seen in FIG. 5) are located on either side of the clamping arm between the clamping arm (16) and the weight structures (23). When the weight structures (23) are placed together about the clamp arm (16), a space (30) is formed between them into which the clamp arm (16) extends. An opening (31A) (visible in FIG. 3) is provided to allow the arm (16) to extend into the space (30). Shield structure (22) covers the opening (31A) through which the arm (16) extends to protect the elastomer

spheres and ribs from the degrading effects of ultraviolet radiation from the sun (col. 5, line 39, through col. 6, line 4).

The Office Action indicates that this shield structure (22) functions in a manner similar to the claimed extension section to prevent the un-numbered portion of the Hawkins clamp (14) from rotating about the Hawkins fastener. For brevity, the Hawkins clamp member with reference number (14) will be referred to herein as the first clamp member (14), and the un-numbered portion of the Hawkins clamp (14) will be referred to herein as the second clamp member (un-numbered). The Office Action cites FIGs. 2 and 3 as a teaching of the claimed extension section.

Attention should first be directed to FIG. 1 of the Hawkins reference. FIG. 1 shows an end elevation view of the back side of the Hawkins damping device, i.e., the opposite side of the device from which the Hawkins fastener head extends. FIG. 1 also shows that the shield structure (22) appears to be integral to the first clamp member (14). Similarly, FIG. 2 shows that the shield structure (22) appears to be integral to the first clamp member (14) because there is no vertical line illustrated in structure (22) that would indicate that the structure is split into to sections. Furthermore, the second clamp member (un-numbered) is illustrated as being curved along a bottom edge that contacts the underlying shield structure (22). Mechanical attachment of two parts, with one having a curved edge, would likely be weak. Moreover, if two parts were mechanically attached, there would be no call for performing the additional, more costly, machining to make one edge curved, since that curved edge would serve no function and yield a weaker joint. Thus, assessment of FIGs. 1-2, absent a teaching within the specification, shows that the second clamp member (un-numbered) is not connected along this bottom edge to the underlying shield structure 22. Consequently, the second clamp member (un-

numbered) can move relative to structure (22). Since second clamp member (un-numbered) can move relative to structure (22), structure (22) cannot serve as the claimed extension section to prevent the second clamp member (un-numbered) from rotating about the Hawkins fastener.

Additional review of FIGs. 1 and 2 reveals that the shield structure (22) appears to be suspended above the weight structures (23) with a gap formed between them. Accordingly, even if the second clamp member (un-numbered) is coupled with a portion of the shield structure (22), which it is not, the second clamp member (un-numbered) would still be able to rotate about the Hawkins fastener at least until the shield structure (22) finally bumps into the vertical wall (31) of the weight halves (23).

Scrutiny of FIG. 3 reveals further ambiguities in the teaching of Hawkins. The gap formed between the shield structure (22) and the weight structures (23) is not clearly visible in the perspective view of the damping device in FIG. 3. The actual configuration of the shield structure (22) is equally unclear since the right hand side of the shield structure (22) appears as one contiguous unit, whereas the left hand side of the structure (22) appears as two units split lengthwise.

Due to the ambiguity of the Hawkins illustrations and to the lack of any teaching in the specification, a presumption that structure exists in the Hawkins damping device to prevent the second clamp member (un-numbered) from rotating about the Hawkins fastener amounts to speculation. That is, hindsight has been employed to confer structure upon the Hawkins device in an attempt to deprecate Applicants' invention of claim 1. As stated in W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 312-313 (Fed. Cir. 1983) cert. denied 469 U.S. 851 (1984):

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To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is Applicants' specification and not the prior art which teaches of an extension section as recited in claim 1. Applicants have discovered that incorporation of the extension section substantially prevents the claimed second clamp member from rotating about the fastener so that it can be rapidly and cost effectively installed on a conductor. Hawkins is not concerned with the problem of fastening the clamp member onto the conductor. Rather, Hawkins is directed toward the utilization of fatigue resistant elastomer damping means to achieve compactness, efficient damping, and easy assembly. To read such an extension section into the Hawkins clamp member, despite the lack of description and despite the ambiguities present in the Hawkins figures, amounts to speculation.

Hawkins fails to teach or suggest of an extension section that prevents rotation of the second clamp member (un-numbered) about the Hawkins fastener. Consequently, the Office Action allegation that it would have been obvious to have the extension section project in a direction transverse to the longitudinal axis of the passageway does not amount to a mere rearrangement of parts. Rather, such a modification entails additional structure taught only in Applicants' specification. That is, one would not be motivated to modify the Hawkins device to more closely resemble Applicants' structure without first having read Applicants' specification.

Consequently, to read such a structure into existence is to read the claims of the present invention into Hawkins. Such mischaracterization of the prior art provides evidence that

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hindsight obtained from Applicants' specification has been used against its teacher and that any finding of obviousness should be reversed.

For the reasons set forth above, Applicants believe that Hawkins fails to render obvious Applicants' invention of amended independent claim 1, and that claim 1 should now be found allowable. Claims 2-3 and 5-10 depend directly or indirectly from claim 1, and are also allowable for the reasons set forth above. Similar to claim 1, independent claim 12 is being amended to include the limitation of the first and second extension sections projecting in a direction transverse to a longitudinal axis of the passageway. As such, the arguments set forth above in connection with claim 1 apply to claim 12 as well. As such, Applicants believe that claim 12 and its dependent claims, i.e., claims 14-19, should now be found allowable.

Claims 8-9, 11, and 17-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hawkins in view of Amos et al., U.S. Patent No. 5,085,583 (hereinafter Amos). Amos teaches of a portable loadmake/loadbreak switch and liveline eyebolt terminal clamp.

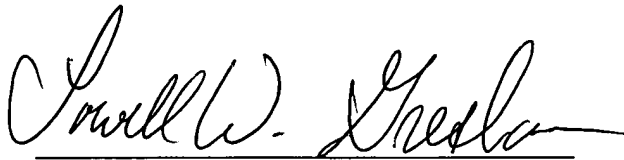
Claim 8-9 depend from amended independent claim 1, and claims 17-18 depend from amended independent claim 12. Thus, claims 8-9 and 17-18 should be found allowable by reason of dependency. Independent claim 11 is being canceled. Consequently, the rejection of claim 11 is moot.

Accordingly, this Amendment cancels claims 4, 11, and 13, and amends claims 1 and 12. Currently amended claims 1 and 12 remain in the application and are believed to be allowable. In addition, claims 2-3, 5-10, and 14-19 remain in the application as originally submitted and are believed to be allowable.

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Applicants believe that the foregoing amendments and remarks are fully responsive to the rejections and/or objections recited in the 20 October 2004 Office Action and that the present application is now in a condition for allowance. Accordingly, reconsideration of the present application is respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, reading "Lowell W. Gresham", is written over a horizontal line.

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